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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,640	07/15/2003	Hideki Sugiura	240356US0	5239
22850	7590	07/22/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,640

Applicant(s)

SUGIURA ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18 and 21, drawn to (a) oxide particles, (b) a toner, and (c) an image forming apparatus, classified in class 106, subclass 446+, class 430, subclass 108.7, and class 399, subclass 252, respectively.

II. Claims 19 and 20, drawn to image forming process, classified in class 430, subclass 126.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I(b) and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the claimed product can be used in a materially different process, such as a process comprising the steps of forming an electrostatic latent image on an image carrier, developing said electrostatic latent image with the toner of Invention I(b), and fixing the developed toner

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image to the image carrier. Such a process does not require transferring the toner image to a recording medium as required in the processes of Invention II.

Invention II and Invention I(c) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by hand. The charging step can be performed by vigorously rubbing the surface of the latent electrostatic image-bearing member with a soft material, such as a cotton or silk handkerchief. The light irradiating step can be performed by placing a transparency comprising a light opaque pattern on the charged latent electrostatic image-bearing member and irradiating light through the transparency with a hand-held light source to form an electrostatic latent image. The developing step can be performed by hand sprinkling a toner onto the image-wise exposed latent electrostatic image-bearing member from a can that comprises the toner. The transfer step can be performed by placing a receiving medium, such as a piece of paper, on the toned image on the image-bearing member and hand pressing the surface of the receiving

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medium to the image member with a block, and then separating the receiving member with the transferred toned image from the image member.

Inventions I(a) and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). In the instant case the different inventions have different functions and different effects. Invention II is drawn to a image forming method that comprises the steps of charging a latent electrostatic image-bearing member, irradiating light to the latent image-bearing member to form a latent electrostatic image, supplying a developer to the latent electrostatic image to form a toner image, and transferring the toner image onto a recording medium. Invention I(c) is drawn to oxide particles, which can be used as a filler for RTV silicon compositions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their different classification, restriction for examination purposes as indicated is proper.

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3. If applicants elect the invention of Group I, which include claims 1-11, they must also respond to the following election of species requirement regarding those claims.

This application contains claims directed to numerous patentably distinct species of the claimed invention.

The distinct oxide fine particles comprising a metal element which is "at least one selected from Mg, Ca, Ba, Al, Ti, V, Sr, Zr, Si, Sn, Zn, Ga, Ge, Cr, Mn, Fe, Co, Ni, and Cu." See instant claim 6. For example, the distinct oxide fine particles are classified in class 106, subclasses 419, 446, 450, 457, 465, 467, 480, 483, etc.

Applicants are required to elect an ultimate species of the invention, wherein the oxide particles comprise a uniquely identified metal element, e.g., Mg.

Applicants should identify all claims that read on the ultimate elected species of invention comprising the oxide particles comprising the uniquely identified metal element.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-11 are generic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected

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consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicants are advised that the reply to this requirement to be complete must include an election of the invention and an

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election of species to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1500~~
1700

JLD

Jul. 18, 2005